

**REMARKS**

Claims 1-34 are pending and under consideration. Claim 1 has been amended to address the error noted by the Examiner. No new matter is presented in this Amendment.

**DOUBLE PATENTING**

Claims 1-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 7,009,926. A terminal disclaimer in compliance with 37 C.F.R. § 1.321 has been filed with respect to U.S. Patent No. 7,009,926. Accordingly, the double patenting rejection should be withdrawn.

Claims 1, 2, 4-9, 12 and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,934,236 (the '936 patent). The applicants respectfully traverse. A terminal disclaimer in compliance with 37 C.F.R. § 1.321 has been filed with respect to U.S. Patent No. 6,934,236. Accordingly, the double patenting rejection should be withdrawn.

**REJECTIONS UNDER 35 U.S.C. §103:**

Claims 1 and 33 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C 103(a) are obvious over Ko, U.S. Patent No. 7,046,605; Ko, U.S. Patent No. 7,142,493; or Ko, U.S. Patent No. 6,868,054 (collectively, the Ko references).

With respect to the 102(e) rejection, the Ko references fail to disclose all the limitations of claims 1 and 33. The Ko references fail to disclose compatibility information allowing a drive following an older version of standards to record and reproduce data with respect to the information storage medium following a new version of standards, as recited in claim 1. The version information disclosed in the Ko references does not allow a drive following an older version of standards to record and reproduce data with respect to the information storage medium following a new version of standards. For example, FIG. 3B of the Ko references indicates that the version information does not allow a drive following an older version of standards to record data with respect to the information storage medium following a new version

of standards. As shown in FIG. 3B, a Ver. 1.9 drive can read data from a disc with "WRITE Ver. 2.0" (a newer write version) and "READ Ver. 1.9", but cannot write data to a disc with "WRITE Ver. 2.0" (FIG. 3B, "READ ONLY OK"). In contrast, claim 1 recites wherein the compatibility information allows a drive following an older version of standards to record and reproduce data with respect to the information storage medium following a new version of standards. Thus, Ko does not disclose all the limitations of claims 1 and 33, and the 102(e) rejection should be withdrawn.

In his rejection the Examiner in fact concedes that the Ko references do not disclose the compatibility information recited in claims 1 and 33 (page 5, "Response to Arguments"; the "version information" is an "obvious" variant of the claimed compatibility information). The Examiner argues that the compatibility information recited in the claims is an "obvious variant" of the version information disclosed in the Ko references. In other words, the Examiner asserts that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the Ko references to include compatibility information instead of version information. This observation is intended to support a rejection of the claims under 35 U.S.C. § 103(a).

With respect to the 103(a) rejection, the 103(a) rejection must be withdrawn because the Ko references do not qualify as prior art under 35 U.S.C. § 103(a). Under 35 U.S.C. §103(c), "[s]ubject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section [§ 103] where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." The Ko references are prior art only under 35 U.S.C. § 102(e), as the issue date for each of the Ko references is later than the filing date of the instant application. The present application was subject to an obligation of assignment to Samsung Electronics, Ltd. on or before the filing date of the instant application, February 13, 2003. The Ko references relied upon by the Examiner were assigned to Samsung Electronics Ltd. prior to the filing date of the instant application. As a result, 35 U.S.C. § 103(c) bars the use of the Ko references as prior art under 35 U.S.C. § 103(a). Accordingly, the rejection of claims 1 and 33 under 35 U.S.C. § 103(a) in view of the Ko references cannot be sustained.

Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over the art as applied to claim 1 and 33 above (the Ko references), and further in view of Tasaka et al. As discussed above, none of the Ko references are available as prior art under 35 U.S.C. § 103(a), and thus the rejection of claim 2 under 35 U.S.C. § 103(a) must be withdrawn.

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over the art as applied to claim 1 above (the Ko references), and further in view of Sasa et al. with respect to the DVD Specification, July version 1.9. As discussed above, none of the Ko references are available as prior art under 35 U.S.C. § 103(a), and thus the rejection of claim 3 under 35 U.S.C. § 103(a) must be withdrawn.

Claims 4, 5, 6, 7, 8, 12, 13, 14, 15, 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over the art as applied to claim 1 above (the Ko references), and further in view of Lim. As discussed above, none of the Ko references are available as prior art under 35 U.S.C. § 103(a), and thus the rejection of the claims under 35 U.S.C. § 103(a) must be withdrawn.

Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over the art as applied to claim 12 above (the combination of one of the Ko references and Lim), and further in view of Miyake et al. As discussed above, none of the Ko references are available as prior art under 35 U.S.C. § 103(a), and thus the rejection of claim 17 under 35 U.S.C. § 103(a) must be withdrawn.

Claims 18, 19, 20, 21, 22, 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Ko references further considered with Miyake et al. As discussed above, none of the Ko references are available as prior art under 35 U.S.C. § 103(a), and thus the rejection of the claims under 35 U.S.C. § 103(a) must be withdrawn.

Claims 24, 25, 26, 27, 28, 29, 30, 31, 32, 34, and 35 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Ko references further considered with Tasaka et al. and

all further considered with Miyake et al. As discussed above, none of the Ko references are available as prior art under 35 U.S.C. § 103(a), and thus the rejection of the claims under 35 U.S.C. § 103(a) must be withdrawn.

#### **DUPLICATE CLAIMS**

The Examiner objected to claim 2 as being substantially duplicative of claim 18, and claim 24 as being substantially duplicative of claim 1. As to claims 2 and 18, claim 2 recites "detecting information about an optimal writing pattern...", while claim 18 recites "detecting strategy information... about which one of a multi-pulse writing strategy and a single-pulse writing strategy". The difference between claim 2 and claim 18 is thus clear. As to claims 1 and 24, claim 1 recites, in part, "detecting compatibility information from at least one of the lead-in and lead-out areas...", and claim 24 recites, in part, "detecting information from one of the lead-in and/or the lead-out areas about an optimal writing pattern used to record data onto the user data area...". The difference between claim 1 and claim 24 is thus clear.

**CONCLUSION:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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